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31 OCT 2006

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In re Application of :
KVITNITSKY, et al. :
U.S. Application No.: 10/553,757 : DECISION ON PETITION
PCT No.: PCT/IL04/00343 :
Int. Filing Date: 21 April 2004 : UNDER 37 CFR 1.47(a)
Priority Date: 21 April 2003 :
Attorney Docket No.: KVITNITSKY1A :
For: STABILIZED DERIVATIVES OF ASCORBIC :
ACID :
:

This decision is in response to the applicant's "Petition Under 37 CFR §1.47 (a) " filed 06 October 2006 in the United States Patent and Trademark Office (UPSTO) to accept the application without the signature of joint inventor Vladimir Babtsov.

BACKGROUND

On 21 April 2004, applicant filed international application PCT/IL04/00343 which claimed priority to an earlier application filed 21 April 2003. A copy of the International Application was forwarded to the United States Patent and Trademark Office (USPTO) from the International Bureau (IB) on 04 November 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 21 October 2005.

On 20 October 2005, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by the requisite basic national fee and a first preliminary amendment.

On 08 August 2005, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 06 October 2006, applicant filed the present petition under 37 CFR 1.47

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied items (1) and (3) above.

Regarding item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part:

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature."

Applicant has provided a firsthand statement from Mr. Ron Folman explaining that prior to the papers being mailed to him inventor Babtsov stated that he would not execute documents for the present application. In addition, applicant has included a declaration from Ms. Beverly Benaroya detailing her efforts to supply Mr. Babstov with a complete set of the application papers accompanied by exhibits showing that the registered mailing was never picked up at the post office. This evidence seems to indicate that Mr. Babstov refused to go to the post office to pick up the mailing consistent with his earlier comments to Mr. Folman that he was not interested in signing any documents for this application. However, the mailing process is not entirely clear. Before the petition can be granted applicant should confirm to the office that Mr. Babstov lived at the address in question when the notice was left. This is to make sure that the parcel was not picked up or delivered since the address was no longer valid. The post office should be able to confirm that if Mr. Babstov no longer lived at the address in question a different notation would have been made. This is necessary since if the inventor had moved additional effort would be necessary to locate a current address.

Regarding item (4), while applicant has submitted a declaration signed by the remaining inventors on their own and on behalf of the non-signing inventors, however, the declaration does not comply with 37 CFR 1.497. The declaration signed by the remaining inventors on their behalf, and on behalf of the non-signing inventor contains three pages numbered "Page 3 of 3 Pages." This suggests that the enclosed declaration was constructed from numerous complete declarations or that the inventors forwarded to counsel only the signatures pages of the declaration. Either alternative renders the submitted declaration defective under 37 CFR 1.497. While each inventor need not execute the same oath or declaration, where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. (See MPEP 201.03 B. Oath or Declaration.)

In light of the above it is not possible to grant applicant's petition under 37 CFR 1.47(a) at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED without prejudice.**

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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